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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,481	10/22/2001	Elliott J. Straus	GT-5410 (GC-GQ)	9731

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EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,481

Applicant(s)

STRAUS ET AL.

Examiner

EDMUND H LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.
2. Applicant's election of claims 17-28 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. The abstract of the disclosure is objected to because it has more than one paragraph. It should be one paragraph. Correction is required. See MPEP § 608.01(b).
4. Claims 17-28 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Maintaining the mold closed or clamped before and/or during in-mold coating application is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The instant specification clearly discloses the importance of not opening or unclamping the mold before and/or during the in-mold coating application. The instant specification also discloses that the mold halves maintain a parting line and generally remain a substantially fixed distance from each other while both the first and second compositions are injected into the mold cavity. See pg 14, lns 3-8 of the instant specification.

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5. Claims 19 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said coated portion" (cl 19, ln 3; cl 25, ln 3) lacks antecedent basis in the claim.

Clarification and/or correction is required.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendry (USPN 4389358). Hendry teaches the claimed process as evidenced by figures 2-5. As seen in figures 2-4, Hendry teaches forming a substrate having at least one area of increased dimensional thickness relative to at least one adjacent area, and a show surface, i.e., the surface that is opposite the surface in contact with mold 72. As seen in figure 5, Hendry teaches coating the substrate on the show surface with an in-mold coating so that the substrate area of increased dimensional thickness is preferentially coated relative to the substrate area without increased dimensional thickness. As seen in figure 5, the flow of the injected material is redirected by element P toward the perimeter of the substrate. As seen in figure 5, the tab/notch near element P extends from the substrate from an in-mold coating injection inlet area to a

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predetermined end location, and the notch/tab has tapered edges that constitute at least two different thicknesses.

8. Claims 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Oda (USPN 4783298). Oda teaches the claimed process as evidenced by figures 1-5.

9. Claims 17-18 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchiyama et al (USPN 6328920). Uchiyama et al teach the claimed process as evidenced by figures 1-5.

10. Claims 17, 19, 20, 23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lutz (USPN 5849168). Lutz teaches the claimed process as evidenced by col 7, lns 44-62. The flat areas between dimples constitute areas of the substrate having increased dimensional thickness. The golf ball having the dimpled surface constitutes a substrate having areas of varying thickness.

11. Claims 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Shima (USPN 4115506). Shima teaches the claimed process as evidenced by figures 1-8.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendry (USPN 4389358). The above teachings of Hendry are incorporated hereinafter.

Hendry teaches the basic claimed process including a notch/tab that includes a thick

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central portion and a relatively thin outer perimeter that surrounds the thick central portion (fig 5). However, Hendry does not teach an outer perimeter that partially surrounds the thick central portion. Such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, projections having the claimed shape are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the claimed design of the tab into the process of Hendry in order to improve bonding between the substrate and the second composition.

14. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz (USPN 5849168). The above teachings of Lutz are incorporated hereinafter. In regard to claim 21, it is well-known in the molding art to inject a composition into a golf ball mold adjacent dimple projections. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject the coating composition of Lutz adjacent a dimple in order to facilitate the spread of the coating composition throughout the mold. In regard to claim 22, Lutz teaches flat areas have tapered sidewalls as is common with dimpled golf balls and a relatively thin outer perimeter that partially surrounds the thick central portion/flat area.

15. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz (USPN 5849168). The above teachings of Lutz are incorporated hereinafter. In regard to claim 27, it is well-known in the molding art to inject a composition into a golf ball mold adjacent dimple projections. Thus, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to inject the coating composition of Lutz adjacent a dimple in order to facilitate the spread of the coating composition throughout the mold. In regard to claim 28, Lutz teaches flat areas have tapered sidewalls as is common with dimpled golf balls and a relatively thin outer perimeter that partially surrounds the thick central portion/flat area.

16. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (USPN 4115506). The above teachings of Shima are incorporated hereinafter. In regard to claim 22, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, projections having the claimed shape are well-known in the molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the claimed design of the tab into the process of Shima in order to improve bonding between the substrate and the second composition, and to facilitate the spread of the composition throughout the mold.


17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bethune (USPN 6558599) teaches the state of the art of in-mold coating.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD CRISPINO can be reached on 703.308.3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7718 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.


EDMUND H LEE
Examiner
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6/11/03

EHL
June 25, 2003